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FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			RUTLEDGE, AMELIA L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/530,786	RICHARD, GREGORY WILLIAM
	Examiner	Art Unit
	AMELIA RUTLEDGE	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 April 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 and 23-31 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-21 and 23-31 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 April 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>04/08/2005</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

1. This action is responsive to the following communications: original application, filed 04/08/2005; Information Disclosure Statement, filed 04/08/2005.
2. Claims 1-21 and 23-31 are pending. Claims 1, 15, 16, 23, and 24 are independent claims.

Claim Objections

Claim 25 is objected to because of the following informalities: claim 25 recites "The apparatus of claim 23, wherein the second processing system is the processing system." The phrasing of claim 25 is unclear, because it is unclear how the "second processing system" could also be "the processing system". Appropriate correction is required.

It appears that claim 13 contains a misspelling of "wire-frame".

It appears that claim 14 contains a misspelling of the word "generates" which should be "generated".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 15 recites: *A method of allowing medical practitioners to demonstrate the effects of a medical condition, or a treatment to an individual, the method being substantially as hereinbefore described.* The method of claim 15 is indefinite, because it is unclear exactly what is being referred to in the phrase *the method being substantially as hereinbefore described*.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15, 23, and 25-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent claim 1, claim 1 recites in part, *a method of allowing medical practitioners to demonstrate the effects of a medical condition or a treatment to an individual using a processing system, the method including causing the processing system to... b) In accordance with the selection, obtain image data, from predetermined image data stored in a store, the image data defining one or more modelled images.* While claim 1 recites "image data stored in a store", the specification does not limit the claimed "store" to computer hardware rather the store may comprise a database or other storage media (p. 10, l. 23-25). Given the broadest reasonable interpretation, claim 1 may be directed to software *per se*, and is non statutory under 35 U.S.C. 101.

Further, as a process claim, the invention claimed in claimed 1 must be tied to another statutory class, such as computer hardware, or transform underlying subject

matter, such as an article or materials, to a different state or thing. It appears that neither of these requirements are met by claim 1 given the broadest reasonable interpretation of the claim limitations.

Regarding dependent claims 2-14, claims 2-14 are rejected because they add no limitations which would render the claimed subject matter statutory.

Regarding independent claim 15, claim 15 is non-statutory because it is directed to an abstract idea, and could be carried out by mental or manual steps, the claimed process is not tied to another statutory class such as an apparatus, and further, there is no useful, concrete, or tangible result produced by the process.

Regarding independent claim 23, claim 23 recites; *a computer program product for allowing medical practitioners to demonstrate the effects of a medical condition, or a treatment to an individual, the computer program product including computer executable code which when executed on a suitable processing system causing the processing system to perform the steps of:*

a) Select a disease or condition, in accordance with an input command received from the medical practitioner;

b) In accordance with the selection, obtain image data, from predetermined image data stored in a store, the image data defining one or more modelled images...

Claim 23 is non-statutory for two reasons; first, claim 23 recites *the computer program product including computer executable code which **when executed** on a suitable processing system causing the processing system to perform the steps of...*

therefore, claim 23 does not positively recite the execution of code, and may therefore be interpreted as non-functional descriptive material.

Second, while claim 23 recites "image data stored in a store", the specification does not limit the claimed "store" to computer hardware rather the store may comprise a database or other storage media (p. 10, l. 23-25). Given the broadest reasonable interpretation, claim 23 may be directed to software *per se*, and is non statutory under 35 U.S.C. 101.

Regarding dependent claims 25-31, claims 25-31 are rejected because they add no limitations which would render the claimed subject matter statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-21 and 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild et al. ("Rothschild"), U.S. Pub. No. 2002/0016718 A1, Appl. No. 09/871,997 filed June 2001, published February 2002, in view of WebMD, selected pages from WebMD website stored at Internet Archive Wayback Machine, http://web.archive.org/web/*/http://webmd.com, pages archived from October 2001, p. 1-19.

Regarding independent claim 1, Rothschild teaches a *method of allowing medical practitioners to demonstrate the effects of a medical condition or a treatment to an individual using a processing system, the method including causing the processing system to*; because Rothschild teaches a medical image management system for use by medical practitioners (par. 0032-0046; par. 0141).

Rothschild suggests that the images can be downloaded by user request (par. 0264-0266), and may be classified by information including patient and study (par. 0101-0102), however, Rothschild does not explicitly teach *a) Select a disease or condition, in accordance with an input command received from the medical practitioner*. WebMD is relied upon to teach *selecting a disease or condition in accordance with an input command received from the medical practitioner*, because WebMD provided an interface for selecting a disease or condition in accordance with an input command, and providing an image of the condition, including animated images and slides (p. 1, "Anatom-E Tools"; p. 3, Heart: Rhythm Disorders; p. 4, "Diseases and Conditions"). WebMD also disclosed an interface for "Health-E-Tools" which included slideshows for diagnosing medical conditions and describing medical procedures (p. 9-15).

Rothschild teaches *b) In accordance with the selection, obtain image data, from predetermined image data stored in a store, the image data defining one or more modelled images*; because Rothschild teaches a database storing medical images to be obtained by the local workstation (par. 0113-0115).

Rothschild teaches *c) Present the one or more of the images on a display; and*,

d) Present annotations on the display in response to one or more input commands; because Rothschild teaches that the user may create overlays on the images, or add attachments to the images such as reports, voice, and video (par. 0110).

Both WebMD and Rothschild were directed to the diagnosis and illustration of medical conditions. It would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to combine the database of patient images disclosed by Rothschild with the user friendly internet interface of WebMD, since Rothschild discloses the need for the use of internet technology to access patient images (par. 0007), and disclosed an internet system to deliver the images (par. 0087-0090), and WebMD provided a flexible interface that would allow either physicians or patients to select a condition and view images and medical information related to the selected condition.

Regarding dependent claim 2, Rothschild teaches *the image data defining one or more image sequences, the method including causing the processing system to*

- a) Present one or more of the images in the image sequence in response to an input commands;*
- b) Select a respective one of the images in response to an input command; and,*
- c) Present image annotations for the selected image.*

Rothschild teaches delivering the image data and image sequence as well as related information and annotations, in response to an input command (Fig. 12; par. 0087-0088; 0224; 0253-0254).

Regarding dependent claim 3, while Rothschild does not explicitly teach wherein the image sequence is animated, WebMD teaches wherein the image sequence is animated. WebMD provided an interface for selecting a disease or condition in accordance with an input command, and providing an image of the condition, including animated images and slides (p. 1, "Anatom-E Tools"; p. 3, Heart: Rhythm Disorders; p. 4, "Diseases and Conditions").

Both WebMD and Rothschild were directed to the diagnosis and illustration of medical conditions. It would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to combine the database of patient images disclosed by Rothschild with the user friendly internet interface of WebMD, since Rothschild discloses the need for the use of internet technology to access patient images (par. 0007), and disclosed an internet system to deliver the images (par. 0087-0090), and WebMD provided a flexible interface that would allow either physicians or patients to select a condition and view images and medical information related to the selected condition.

Regarding dependent claim 4, Rothschild teaches the annotations including at least one of: a) Text annotations; and, b) Drawings annotations (Fig. 12; par. 0087-0088; 0224; 0253-0254).

Regarding dependent claim 5, Rothschild teaches the method including causing the processing system to superimpose the annotations on the respective image (Fig. 12; par. 0087-0088; 0224; 0253-0254).

Regarding dependent claim 6, Rothschild teaches the method including causing the processing system to store the annotations in a store in accordance with an input command, because Rothschild teaches storing the annotations and image file in the relational database (par. 00253-0254).

Regarding dependent claim 7, Rothschild teaches the stored annotations forming part of the individual's medical records (par. 0224; 0207-0211).

Regarding dependent claim 8, Rothschild teaches the store being coupled to one or more processing systems by the communications network, the method including allowing selected medical practitioners to access the patients medical records via communications network using a respective one of the processing systems (par. 0207-0211).

Regarding dependent claim 9, Rothschild teaches the method including causing the processing system to superimpose the annotations on the respective image, and store the annotations together with at least an indication of the respective image, because Rothschild teaches overlay annotations (Fig. 12; par. 0087-0088; 0224; 0253-0254).

Regarding dependent claim 10, Rothschild teaches the method including causing the processing system to store the annotation as a respective image annotations (Fig. 12; par. 0087-0088; 0224; 0253-0254).

Regarding dependent claim 11, Rothschild teaches the method including causing the processing system to store additional information together with the annotations, the additional information including at least one of: a) The patient identity;

b) The medical practitioner identity; c) A diagnosis; and, d) A time and/or date indication representative of when the annotations were created (par. 0224; 0207-0211; Fig. 12; par. 0087-0088; 0224; 0253-0254).

Regarding dependent claim 12, Rothschild teaches the processing system being coupled to one or more end stations via a communications network, the method including causing the processing system to: a) Receive input commands from the end stations via the communications network; and, b) Present the image(s) and the annotations to the medical practitioner using the end station, because Rothschild teaches an email messaging embodiment (par. 0253), and an input device (par. 0267-0268; 0265), and teaches a communications network, the internet (par. 0221-0230).

Regarding dependent claims 13 and 14, while Rothschild does not explicitly teach wherein the modelled images are wire-frame modelled, pre-defined computer generated images, Web-MD discloses animated three-dimensional, i.e., wire frame modeled, images (p. 1, "Anatom-E Tools"; p. 3, Heart: Rhythm Disorders; p. 4, "Diseases and Conditions").

Both WebMD and Rothschild were directed to the diagnosis and illustration of medical conditions. It would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to combine the database of patient images disclosed by Rothschild with the user friendly internet interface of WebMD, since Rothschild discloses the need for the use of internet technology to access patient images (par. 0007), and disclosed an internet system to deliver the images (par. 0087-0090), and WebMD provided a flexible interface that would allow either physicians or patients to

select a condition and view images and medical information related to the selected condition.

Regarding independent claim 15, claim 15 is rejected along the same rationale as independent claim 1.

Regarding independent claim 16, Rothschild teaches a *processing system for allowing medical practitioners to demonstrate the effects of a medical condition, or a treatment to an individual, the processing system including:*

a) A store for storing image data, the image data defining one or more modelled images; because Rothschild teaches a medical image management system for use by medical practitioners (par. 0032-0046; par. 0141). Rothschild teaches a database storing medical images to be obtained by the local workstation (par. 0113-0115).

Rothschild teaches b) An input for receiving input commands from the medical practitioner, and c) A display for displaying the images; because Rothschild teaches a database storing medical images to be obtained by the local workstation (par. 0113-0115), where the input commands from the medical practitioner are entered into the local workstation.

Rothschild suggests that the images can be downloaded by user request (par. 0264-0266), and may be classified by information including patient and study (par. 0101-0102), however, Rothschild does not explicitly teach d) A processor, the processor being adapted to: i) Present one or more of the images on the display in response to an input command; WebMD is relied upon to teach i) Present one or more of the images on the display in response to an input command, because WebMD provided an interface

for selecting a disease or condition in accordance with an input command, and providing an image of the condition, including animated images and slides (p. 1, "Anatom-E Tools"; p. 3, Heart: Rhythm Disorders; p. 4, "Diseases and Conditions"). WebMD also disclosed an interface for "Health-E-Tools" which included slideshows for diagnosing medical conditions and describing medical procedures (p. 9-15).

Rothschild teaches *ii) Present annotations on the display in response to one or more input commands*; because Rothschild teaches that the user may create overlays on the images, or add attachments to the images such as reports, voice, and video (par. 0110). Rothschild teaches displaying the images (Fig. 6).

Both WebMD and Rothschild were directed to the diagnosis and illustration of medical conditions. It would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to combine the database of patient images disclosed by Rothschild with the user friendly internet interface of WebMD, since Rothschild discloses the need for the use of internet technology to access patient images (par. 0007), and disclosed an internet system to deliver the images (par. 0087-0090), and WebMD provided a flexible interface that would allow either physicians or patients to select a condition and view images and medical information related to the selected condition.

Regarding dependent claim 17, claim 17 is directed to substantially similar subject matter as claimed in dependent claim 6, and is rejected along the same rationale.

Regarding dependent claim 18, Rothschild teaches the processing system being coupled to a database, the processing system being adapted to store the annotations in the database, because Rothschild teaches a database storing medical images and annotations to be obtained by the local workstation (par. 0113-0115).

Regarding dependent claim 19, Rothschild teaches the processing system being coupled to the database via a communications network, because Rothschild teaches an email messaging embodiment (par. 0253), and an input device (par. 0267-0268; 0265), and teaches a communications network, the internet, to connect the processing system to the database (par. 0221-0230).

Regarding dependent claim 20, Rothschild teaches a processing system, the processor and the store being provided at a base station, the base station being coupled to one or more remote end stations via a communications system, the input and the display being formed from the end stations, because Rothschild teaches a database storing medical images to be obtained by the local workstation (par. 0113-0115)..

Regarding dependent claim 21, claim 21 is directed to substantially similar subject matter as claimed in independent claim 1, and is rejected along the same rationale.

Regarding independent claim 23, claim 23 is directed to substantially similar subject matter as claimed in independent claim 1, and is rejected along the same rationale.

Regarding independent claim 24, Rothschild teaches *an apparatus for handling medical records, the records including a representation of a medical condition or treatment to be applied to an individual, the apparatus including a processing system, having: a) A database*; because Rothschild teaches a medical image management system for use by medical practitioners (par. 0032-0046; par. 0141). Rothschild teaches a database storing medical images to be obtained by the local workstation (par. 0113-0115).

Rothschild teaches *b) A processor coupled to the database, the processor being adapted; and, i) Determine the medical records; and, ii) Store the medical records in the database*; because Rothschild teaches determining medical records and storing them in the database (par. 0224; 0207-0211; Fig. 12; par. 0087-0088; 0224; 0253-0254).

Rothschild teaches *wherein the medical records include an image together with one or more associated annotations, the medical records being generated by a second processing system*, because Rothschild teaches that the user may create overlays on the images, or add attachments to the images such as reports, voice, and video (par. 0110).

Rothschild suggests but does not explicitly teach *wherein the second processing system is adapted to: a) Obtain image data in accordance with an input command received from a medical practitioner, then image data defining one or more images*; WebMD is relied upon to teach *a) Obtain image data in accordance with an input command received from a medical practitioner, then image data defining one or more images*; because WebMD provided an interface for selecting a disease or condition in

accordance with an input command, and providing an image of the condition, including animated images and slides (p. 1, "Anatom-E Tools"; p. 3, Heart: Rhythm Disorders; p. 4, "Diseases and Conditions"). WebMD also disclosed an interface for "Health-E-Tools" which included slideshows for diagnosing medical conditions and describing medical procedures (p. 9-15).

Rothschild teaches *b) Present the one or more of the images on a display; and, c) Present annotations on the display in response to one or more input commands*, because Rothschild teaches displaying the images (Fig. 6). Rothschild teaches that the user may create overlays on the images, or add attachments to the images such as reports, voice, and video (par. 0110).

Both WebMD and Rothschild were directed to the diagnosis and illustration of medical conditions. It would have been obvious and desirable to one of ordinary skill in the art at the time of the invention to combine the database of patient images disclosed by Rothschild with the user friendly internet interface of WebMD, since Rothschild discloses the need for the use of internet technology to access patient images (par. 0007), and disclosed an internet system to deliver the images (par. 0087-0090), and WebMD provided a flexible interface that would allow either physicians or patients to select a condition and view images and medical information related to the selected condition.

Regarding dependent claim 25, Rothschild teaches alternative embodiments including first and second processing systems (Fig. 9).

Regarding dependent claim 26, Rothschild teaches *the processing system being coupled to one or more end stations via a communications network, the processor being adapted to: a) Receive a medical record request from the end station; and, b) Transfer a selected medical record to the end station in accordance with the request*, because Rothschild teaches an email messaging embodiment (par. 0253), and an input device (par. 0267-0268; 0265), and teaches a communications network, the internet, to connect the processing system to the database (par. 0221-0230).

Regarding dependent claim 27, Rothschild teaches *the request including an indication of the medical practitioner making the request, the processor being further adapted to: a) Compare the practitioner indication to practitioner data stored in a store, the practitioner data indicating authorisations for the viewing of medical records; b) Determine if the medical practitioner is authorised to view the selected medical record; and c) Transferring the medical record in accordance with a successful determination*; because Rothschild teaches authorization logic (par. 0105).

Regarding dependent claim 28, claim 28 is directed to substantially similar subject matter as claimed in independent claim 1, and is rejected along the same rationale.

Regarding dependent claim 29, claim 29 is directed to substantially similar subject matter as claimed in independent claim 1, and is rejected along the same rationale.

Regarding dependent claim 30, Rothschild teaches *the database being coupled to one or more processing systems by a communications network, thereby*

allowing the selected medical practitioners to access the patients medical records via the database using the processing systems, because Rothschild teaches an email messaging embodiment (par. 0253), and an input device (par. 0267-0268; 0265), and teaches a communications network, the internet, to connect the processing system to the database (par. 0221-0230).

Regarding dependent claim 31, claim 31 is directed to substantially similar subject matter as claimed in independent claim 1, and is rejected along the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roy et al.	U.S. Patent No. 7,106,479 B2	issued	September 2006
Bodicker et al.	U.S. Patent No. 7,050,611 B2	issued	May 2006
Judd et al.	U.S. Patent No. 6,934,698 B2	issued	August 2005
Osaki et al.	U.S. Patent No. 6,675,352 B1	issued	January 2004
Yamada et al.	U.S. Patent No. 5,235,510	issued	August 1993

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMELIA RUTLEDGE whose telephone number is (571)272-7508. The examiner can normally be reached on Monday - Friday 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amelia Rutledge/
Examiner, Art Unit 2176